

DETAILED ACTION

1 The Non-Final Office Action that was sent on 10/08/2008 is withdrawn and Supplemental amended filed on 09/09/2008 has been considered. Supplemental amended claims are rejected under 35 U.S.C 101 rejections and 35 U.S.C 112, first Paragraph, as failing to comply with the written description requirement, in condition for allowance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 12, 23, 30, 31, 32, 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim limitation, "Searching for a prediction value corresponding to said pixel", is not disclosed by the originally filed specification, "said pixel" refers to an encoded bit string pixel which the number bits is limited in the encoded bit string of the pixel", recited in the preamble. The originally filed specification teaches the search is done on the original pixel with the original bit string (10 bits) and is not done on the encoded bit string pixel (8 bits), as described in the original specification, see paragraph [0031].

Art Unit: 2624

4. Claims 1, 12, 23, 30, 31, 32, 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "searching for a prediction value corresponding to bit string of original pixel", does not reasonably provide enablement for "Searching for a prediction value corresponding to said pixel", "said pixel" refers to an encoded bit string pixel which the number bits is limited in the encoded bit string of the pixel", recited in the preamble. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use, the invention commensurate in scope with these claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 12, 23, 30, 31, 32, 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim limitation, "searching for a prediction value corresponding to said pixel", "said pixel" refers to an encoded bit string pixel which the number bits is limited in the encoded bit string of the pixel", recited in the preamble has no support in the specification.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Remark: 101 machine test analysis or Transformation test analysis

1. Claim 1 does not have a particular machine in claim limitations such as a “computer” or “processor” or “image processor”, therefore, claim has failed to pass the machine test analysis.

2. Claim 1 does not have (a) physical or chemical transformation of a physical object, (b) no modification to data or signal; (c) claim 1 has display in line 1, 4 and 7; (d) Modification and or transformation not meaningful or significant. Therefore claim 1 has failed to pass transformation test analysis.

8. Claims 1-3, 5-14 and 16-38 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. The Federal Circuit¹, relying upon Supreme Court precedent², has indicated that a statutory “process” under 35 U.S.C. 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This is referred to as the “machine or transformation test”, whereby the recitation of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility (See *Benson*, 409 U.S. at 71-72), and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See *Flook*, 437 U.S. at 590”). While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform an article nor are positively tied to a particular machine that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

¹ *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

² *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AKLILU k. WOLDEMARIAM whose telephone number is (571)270-3247. The examiner can normally be reached on Monday-Thursday 6:30 a.m-5:00 p.m EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached on 571-272-7413. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner
Art Unit 2624

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